

### **REMARKS**

Applicants have reviewed the Office Action mailed June 24, 2009. No claims are amended. Claims 1, 4-8, 10, and 12-38 are pending. Applicants request reconsideration.

Claims 1, 7, 12-17, 19-24, 27-30, and 35-37 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Ebert (GB 2151201) in view of Monte (U.S. Patent No. 5,578,336) and Brox (U.S. Patent No. 4,780,316).

Claims 1, 4-7, 11, 12, 15-17, 19-30, and 35-37 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Ebert in view of Cavanak (U.S. Patent No. 5,639,724) and Brox.

These two rejections are traversed together.

The issue between Applicants and the Examiner appears to be clear. The Examiner's reasoning has relied on storage for extended periods of time as disclosing the aging step of the present claims. Applicants amended the claims to recite drying for a period of 5 to 64 hours.

Applicants previously submitted that Brox's storage condition of zero months is equivalent to no drying/aging at all, i.e. a time of zero hours, which is outside the claimed floor of 5 hours. In the Response to Arguments, the Examiner asserted that zero month includes any time under a month, which could be hours or days. The Examiner also asserted that one month attains the claimed effect because there is no particular upper limit for aging time since the effect of the aging saturates.

In reply, Applicants submit zero months cannot include any time under a month. In Table 2, Brox lists times of 0, 1, and 3.5 months. Brox appears to state his storage period using an accuracy of 0.1 month, which excludes at the very least periods of 0.2-0.9 months. Applicants again submit that the most reasonable interpretation of Brox's zero months is a baseline, or zero hours. This is again outside the claimed floor of 5 hours.

The Examiner's assertion that drying the product of Ebert and Monte for the one-month period of Brox creates a product that renders obvious the presently claimed capsules is also incorrect. In response, Applicants submit that there is no motivation to

combine the references as the Examiner has. Both Ebert and Monte teach and suggest their combination of capsule and fill material should be a heterogeneous composition. Ebert discloses that his purpose is to obtain a chewable capsule that leaves a chewable, insoluble residue in the mouth which does not change significantly in size, texture, or consistency. See column 1, lines 19-39. It is clear from this statement that the shell and the fill material should be heterogeneous from each other. Monte also teaches that one of his coatings should be crunchy. See column 2, lines 62-67. In other words, Monte contemplates that this crunchy coating is separate, i.e. heterogeneous, from the fill material. Thus, both Ebert and Monte teach and suggest a heterogeneous composition. However, the present claims specifically require a homogeneous composition. See also page 1, lines 19-22, which state that the capsule is desirably immediately soluble. The Examiner proposes that Brox's storage time achieves this homogeneity. Applicants submit that Ebert and Monte would teach away from such a result using Brox's storage time because they desire a heterogeneous composition.

Similarly, the combination of Ebert with Cavanak results in a heterogeneous composition. Cavanak discloses that his fill material is liquid or bi-phasic, i.e. separates into two phases. See column 11, line 56 to column 12, line 12. Thus, this combination is also heterogeneous, and not homogeneous as required by the claims.

These disclosures that the combination of shell and fill material should be heterogeneous show that the dried fill material does not exhibit the claimed property.

For at least these reasons, the claims are not obvious. Applicants request withdrawal of these two § 103(a) rejections.

Claims 1, 4-7, 11, 12, 15-17, 19, 20, 22, 24-30, and 35-37 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Lech (U.S. Patent No. 6,027,746) in view of Cavanak.

Claims 8, 12-16 and 31-37 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Lech, in view of Cavanak and Katsuragi (U.S. Patent No. 5,756,543).

Claims 17 and 18 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Lech in view of Mehta (U.S. Patent No. 5,084,278).

Applicants traverse these three rejections together.

Applicants submit that the combination of Lech with Cavanak results in a heterogeneous composition, not a homogeneous composition as required by the claims. Lech teaches solid or liquid oral suspensions within a soft gelatin capsule. Lech also teaches that the shell and the filler should be different, i.e. heterogeneous, to prevent the shell from degrading and breaking down. See column 5, lines 42-53. Any suggestion that the resulting composition is homogeneous is rebutted by the disclosure of Lech. Similarly, the combination of Lech and Mehta is still heterogeneous, not homogeneous. These disclosures that the combination of shell and fill material should be heterogeneous show that the dried fill material does not exhibit the claimed property.

Applicants previously argued that Lech's disclosure of "extended periods" of storage was ambiguous and that it was the Examiner's burden to show the meaning of this phrase. In the Response to Arguments, the Examiner asserted that one cannot show nonobviousness by attacking references individually when the rejections are based on combinations of references.

The Examiner's assertion is not completely correct. A combination of two references necessarily combines disclosure that is present in only one reference, and thus an attack on one reference is still an attack on the combination of references. For example, if the Examiner relies on reference 1 to teach A and reference 2 to teach B, and Applicants respond that reference 1 does not teach A, that constitutes an attack on the combination of references. Here, the Examiner relied on Lech to teach the aging step. Applicants merely argued that Lech did not teach this step, and the Examiner does not rely on Cavanak for this teaching. This is a proper attack on the combination of references.

Applicants also previously argued that U.S. Patent No. 6,071,523 to Mehta provided a reasonable basis for construing the "extended periods" of Lech to be longer than the claimed 64 hours. In the Response to Arguments section of the Office Action, the Examiner asserted that Lech does refer to a time period that falls within the claimed

range, and that there is no particular upper limit for aging time since the effect of the aging saturates.

The Examiner's first assertion is still incorrect. Lech states only "extended periods" of time, and there is no indication that this time period falls within the claimed range of 5 hours to 64 hours. The Examiner's second assertion does not overcome the fact that the combination of Lech and Cavanak is heterogenous, not homogeneous.

Applicants request withdrawal of these three 103(a) rejections.

Claim 10 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Ebert, in view of Monte or Cavanak, and Nishizawa (U.S. Patent No. 4,463,024). Applicants traverse the rejection.

The Examiner claimed it would have been obvious to use the bitter chocolate of Nishizawa to obtain a superior flavoring composition, citing Example 18. Nishizawa does not make this teaching. Rather, Nishizawa discloses that adding a flavoring wooden material produces a superior flavoring composition. Please note that at the end of Example 18, in column 11, the flavoring material obtained in Example 3 is added to achieve the excellent flavor and taste.

Applicants request withdrawal of the § 103(a) rejection.

**CONCLUSION**

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1, 4-8, 10, and 1-38) are now in condition for allowance.

In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call Richard M. Klein, at telephone number 216-363-9000, Cleveland, OH.

Respectfully submitted,

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2/26/10  
Date

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